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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/428,036	10/27/1999	KEVIN H. NEWTON	D-1124	4122

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EXAMINER
MORGAN, ROBERT W

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/428,036	NEWTON ET AL.	
	Examiner	Art Unit	
	Robert W. Morgan	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 September 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 10-14, 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,502,944 to Kraft et al.

As per claim 1, Kraft et al. teaches method comprising the step of:

(a) the claim storing in at least one data store in operative connection with at least one computer, data representative of at least one patient and at least one medical item prescribed for use by the patient is met by storing information concerning a patient's medication requirements on the pharmacy system (14, Fig. 1) (see: column 4, lines 56-59);

(b) the claimed storing in the data store, data representative of a plurality of holding locations for medical items in a medical item dispenser, a plurality of types of medical items, and for each of the storage locations, a type medical item stored in the respective storage location is

met by the pharmacy computer system that maintains a database of the medication, the manufacturer, the brand name, the generic name, the dosage form, the location of the drug in the pharmacy, and pricing information (see: column 1, lines 29-34);

(c) the claimed inputting through an input device in operative connection with the computer and the dispenser, data corresponding to the patient is met by keyboard (28, Fig. 2);

(d) the claimed dispensing from the responsive to the data stored in the data store, the type medical item prescribed for use by the patient, wherein the type medical item in dispensed from a storage location holding the type medical item in the dispenser is met by the dispensing process where the nurse enter commands through the system controller (34, Fig. 3) to retrieve medication for one or more patients (see: column 4, lines 54-56);

(e) the claimed including in the data store responsive to execution of step (d), data representative that the type medical item has been dispensed for use by the patient, and that the type medical item has been dispensed from the dispenser is met once the nurse orders all or part of the authorized medication for each of the nurse's patients for a given medication round, the medication dispenser (12, Fig. 1) retrieves each medication from its respective container and dispenses the medication (see: column 4, lines 60-65).

As per claim 10, Kraft et al. teaches the claimed step (d) further comprising the step of displaying on an output device adjacent to the dispenser, display indicia including indicia indicative of the type medical item. This feature is met by the video display (26, Fig. 2) and printer (30, Fig. 2) connected to the medication dispenser (see: column 4, lines 3-15 and Fig. 2).

As per claim 11, Kraft et al. teaches prior to step (d) further comprising the step of receiving an input through an input device indicating agreement with the display indicia. The

dispensing process meets this feature where the nurse enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2) connected to the medication dispenser (see: column 4, lines 54-56).

As per claim 12, Kraft et al. teaches prior to step (a), inputting through a physician terminal in operative connection with the computer, prescription data representative of information that the medical item has been prescribed for the patient, and a medical condition for which the medical item has been prescribed, wherein in step (a) the data stored includes prescription data, and wherein in the displaying step the display indicia includes indicia indicative of the medical condition. The dispensing process meets this limitation where the nurse enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2) and video display (26, Fig. 2) connected to the medication dispenser (see: column 4, lines 54-56). The information concerning the patient medication requirement is stored in the pharmacy system (14, Fig. 1) and when the medication package given to the patient include a label with information such as patient's name, room number, doctor's name and other data as required (see: column 4, lines 60 to column 5, lines 2).

As per claims 13-14, Kraft et al. teaches a dispensing process where the nurse enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2), video display (26, Fig. 2) and printer (30, Fig. 2) all connected to the medication dispenser (see: column 4, lines 54-56). The information concerning the patient medication requirement is stored in the pharmacy system (14, Fig. 1) and when the medication package given to the patient include a label with information such as patient's name, room number, doctor's name and other data as required (see: column 4, lines 60 to column 5, lines 2).

As per claim 26, Kraft et al. teaches a dispensing process where the nurse enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2), video display (26, Fig. 2) and printer (30, Fig. 2) all connected to the medication dispenser (see: column 4, lines 54-56). The information concerning the patient medication requirement is stored in the pharmacy system (14, Fig. 1) and when the medication package given to the patient include a label with information such as patient's name, room number, doctor's name and other data as required (see: column 4, lines 60 to column 5, lines 2). Kraft et al. further teaches a vision subsystem (44, Fig. 4) that interacts with the medication unit from a selected container to the medication package subsystem (38, Fig. 3) (see: column 6, lines 35-37). In addition, the vision subsystem (44, Fig. 4) comprises two optic systems for comparing specific medication in order to verify that the correct medication is being dispensed (see: column 7, lines 26-34). The Examiner considers the comparison for dispensing purposes to include checking data representative of a medical history of the patient corresponding to inputted patient data.

As per claim 27, Kraft et al. teaches a plurality of medication dispenser (12, Fig. 1) coupled to a pharmacy computer system (14, Fig. 1) and to each other through a network (16, Fig. 1) (Internet) (see: column 52-55). In addition, the vision subsystem (44, Fig. 4) compares specific medication in order to verify that the correct medication is being dispensed (see: column 7, lines 26-34). The Examiner considers the comparison for dispensing purposes to include checking data representative of a medical history of the patient corresponding to inputted patient data.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2, 9 and 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,502,944 to Kraft et al. in view U.S. Patent No. 5,797,515 to Liff et al.

As per claim 2, Kraft et al. teaches a medication dispensing system that storing information concerning a patient's medication requirements on the pharmacy system (14, Fig. 1) (see: column 4, lines 56-59). Kraft et al. further teaches a pharmacy computer system (14, Fig. 1) which maintains a database of the medication, the manufacturer, the brand name, the generic name, the dosage form, the location of the drug in the pharmacy, and pricing information (see: column 1, lines 29-34). In addition, Kraft et al. teach a dispensing process where the nurse enters commands through the system controller (34, Fig. 3) to retrieve medication for one or more patients (see: column 4, lines 54-56).

Kraft et al. fails to teach data representative of a benefit plan associated with the patient, and payment rules concerning payment for medical items associated with the benefit plan and further comprising the step of charging for the dispensed medical item in accordance with the payment rules.

Liff et al. teaches a drug dispensing system that uses an electronic third-party payor card for drug purchases at the doctor's office (see: column 4, lines 67 to column 5, lines 2). Liff et al. also teaches that during the claim adjudication step (286, Fig. 12) a patient's insurance information is automatically verified to determine whether the insurer will pay for the

prescription and if any co-payment is required (see: column 13, lines 12-42 and column 16, lines 40-52). The Examiner considers the step of verifying insurance and payment information a form of evaluating the rules and regulation associated with making a payment for a prescription.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the drug dispensing system as taught by Liff et al. within the medication dispensing system as taught by Kraft et al. with the motivation of having a patient's insurance information readily available at the physician's office, thereby avoiding the inconvenience of taking a trip the pharmacy (see: Liff et al.: column 4, lines 62-64).

As per claim 9, Kraft et al. teaches a medication dispensing system that storing information concerning a patient's medication requirements on the pharmacy system (14, Fig. 1) (see: column 4, lines 56-59). Kraft et al. further teaches a pharmacy computer system (14, Fig. 1) which maintains a database of the medication, the manufacturer, the brand name, the generic name, the dosage form, the location of the drug in the pharmacy, and pricing information (see: column 1, lines 29-34). In addition, Kraft et al. teaches a dispensing process where the nurse enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2) to retrieve medication for one or more patients (see: column 4, lines 54-56).

Kraft et al. fails to teach storing and inputting data representative of a benefit plan associated with the patient. Kraft et al. also fails to teach charging for the medical item in accordance with the payment rules associated with the benefit plan determined to be associated with the patient.

Liff et al. teaches a host computer (46, Fig. 1) using pharmacy software packages that provide standard administrative and accounting capabilities and support features of the

dispensing system such as a document printer (60, Fig. 1), that generates documents containing instruction for the patient or the practitioner and a keyboard (50, Fig. 1) that inputs the commands of the user (see: column 5, lines 19-25, 58-63 and column 7, lines 24-37). Liff et al. also teaches during the claim adjudication step (286, Fig. 12) a patient's insurance information is automatically verified to determine whether the insurer will pay for the prescription and if any co-payment is required (see: column 13, lines 12-42, column 16, lines 40-52 and Fig. 1).

The motivation for combining the teaching of Kraft et al. and Liff et al. are discussed in the rejection of claim 2, and are incorporated herein.

As per claim 15, Liff et al. teaches a document printer that prints instructions specific to a dispensed pharmaceutical for use by the patient or medical practitioner (see: column 2, lines 58-67).

As per claim 16, Kraft et al. teaches a medication dispensing system that storing information concerning a patient's medication requirements on the pharmacy system (14, Fig. 1) (see: column 4, lines 56-59). Kraft et al. further teaches a dispensing process where the nurse enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2), video display (26, Fig. 2) and printer (30, Fig. 2) all connected to the medication dispenser (see: column 4, lines 54-56). The information concerning the patient medication requirement is stored in the pharmacy system (14, Fig. 1) and when the medication package given to the patient include a label with information such as patient's name, room number, doctor's name and other data as required (see: column 4, lines 60 to column 5, lines 2). In addition, Kraft et al. teaches a dispensing process where the nurse enters commands through the system controller (34, Fig. 3)

using a keyboard (28, Fig. 2) to retrieve medication for one or more patients (see: column 4, lines 54-56).

As per claims 17 and 18, Liff et al. teaches the step of applying to the type medical item, indicia indicative of data included in the prescription data and prescription data including instruction for using the type medical item and the medical item includes indicia indicative of the instruction (see: column 5, lines 58-63).

As per claim 19, Liff et al. teaches the step of printing a prescription label, wherein the prescription label includes the indicia indicative of the data included in the prescription data, wherein in the applying step the label is applied in connection with the type medical item (see: column 5, lines 58-63).

As per claims 20 and 21, Kraft et al. teaches applying the step of executing the prior to step (d), wherein the indicia indicative of data included in prescription data is applied to the type medical item to be dispensed in step (d). This feature is met by each medication package for a given patient are labeled with information including patient's name, room number, doctor's name and other data as required (see: column 4, lines 60 to column 5, lines 2).

As per claim 22, Liff et al. teaches a label printer coupled to the controller for printing a patient prescription label for attaching to a dispensed pharmaceutical package. The label printer is inhibited until the bar-code reader verifies that the proper dispensing of the pharmaceutical has occurred (see: column 2, lines 53-67).

As per claim 23, Kraft et al. and Liff et al. teaches a medication dispensing system that storing information concerning a patient's medication requirements on the pharmacy system (14, Fig. 1) (see: column 4, lines 56-59). Kraft et al. further teaches a dispensing process where the

nurse enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2), video display (26, Fig. 2) and printer (30, Fig. 2) all connected to the medication dispenser (see: Kraft et al.: column 4, lines 54-56). The information concerning the patient medication requirement is stored in the pharmacy system (14, Fig. 1) and when the medication package given to the patient include a label with information such as patient's name, room number, doctor's name and other data as required (see: Kraft et al.: column 4, lines 60 to column 5, lines 2). In addition, Kraft et al. teaches a dispensing process where the nurse enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2) to retrieve medication for one or more patients (see: Kraft et al.: column 4, lines 54-56). Additionally, Kraft et al. and Liff et al. teaches that a licensed user, for example, a doctor, pharmacist, nurse, or other medical practitioner using a keyboard (50, Fig. 1) enters a command to request dispensing of a particular package pharmaceutical variety (32, Fig. 1) for a particular patient (see: Liff et al. column 5, lines 19-25).

5. Claims 3-8, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,502,944 to Kraft et al. in view U.S. Patent No. 5,797,515 to Liff et al. in further view of Official Notice.

As per claim 3, Kraft et al. and Liff et al. teaches a card reader (38, Fig. 1) mounted directly to or near the cabinet and connected to the host computer (46, Fig. 1), where the patient inserts a card (39, Fig. 1) in the card reader (38, Fig. 1) to automatically receive medicine from the cabinet (see: Liff et al.: column 5 lines 47-53 and Fig. 1).

Kraft et al. and Liff et al. fail to teach a reading a credit or debit card with a card reading device adjacent the dispenser, wherein the card reading device is in operative connection with

the computer, and the charging step includes charging an account associated with the credit or debit card.

The Examiner takes Official Notice that, in the medical industry, the use of cash, checks or credit cards are old and well-known methods of payment for patient health care. One of ordinary skill in the art would have found it obvious at the time the invention was made to include the charging of a customer's credit or debit card with the system as taught by the Kraft et al. and Liff et al. with the motivation of providing a fast and beneficial way for customers to make purchase and payment for prescription medicine.

As per claims 4-6, Kraft et al. and Liff et al. et al. teaches a drug dispensing system that uses an electronic third-party payor card for drug purchases at the doctor's office (see: Liff et al. column 4, lines 67 to column 5, lines 2). Kraft et al. and Liff et al. also teaches that during the claim adjudication step (286, Fig. 12) a patient's insurance information is automatically verified to determine whether the insurer will pay for the prescription and if any co-payment is required (see: Liff et al. column 13, lines 12-42 and column 16, lines 40-52).

Kraft et al. and Liff et al. fail to explicitly teach a charging step of charging the benefits provider, charging the co-pay amount and charging the benefits provider the benefit amount. The Examiner takes Official Notice that, in the medical industry cash, checks or credit cards are old and well-known methods of payment for patient health care, for instance, a patient may have to pay a deductible to be seen by a their physician usually about $10-15 dollars with a credit card and the patient's medical insurance company would pay for the remaining amount.

The motivation for combining the teaching of Kraft et al. and Liff et al. are discussed in the rejection of claim 3, and are incorporated herein.

As per claims 7 and 8, Kraft et al. and Liff et al. fail to explicitly teach inputting and outputting information representative of the co-payment amount and acceptance of the co-pay amount.

However, Kraft et al. and Liff et al. teach a host computer (46, Fig. 1) using pharmacy software packages that provide standard administrative and accounting capabilities and support features of the dispensing system such as a document printer (60, Fig. 1), that generates documents containing instruction for the patient or the practitioner and a keyboard (50, Fig. 1) that inputs the commands of the user (see: Liff et al. column 5, lines 19-25, 58-63 and column 7, lines 24-37). Kraft et al. and Liff et al. also teach during the claim adjudication step (286, Fig. 12) a patient's insurance information is automatically verified to determine whether the insurer will pay for the prescription and if any co-payment is required (see: Liff et al. column 13, lines 12-42, column 16, lines 40-52 and Fig. 1).

The motivation for combining the teaching of Kraft et al. and Liff et al. are discussed in the rejection of claim 3, and are incorporated herein.

As per claim 24, Kraft et al. and Liff et al. teaches a dispensing process where the nurse enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2) to retrieve medication for one or more patients (see: Kraft et al.: column 4, lines 54-56). Kraft et al. and Liff et al. also teaches that a licensed user, for example, a doctor, pharmacist, nurse, or other medical practitioner using a keyboard (50, Fig. 1) enters a command to request dispensing of a particular package pharmaceutical variety (32, Fig. 1) for a particular patient (see: Liff et al. column 5, lines 19-25).

Kraft et al. and Liff et al. fail to teach contacting the patient corresponding to the data inputted in step (c) after failing to executing step (d).

The Examiner takes Official Notice that it is common in the medical field, for a patient or a physician to be contacted if the pharmacist in order to clarify any discrepancies or make any modification to the prescription does not verify prescription information. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of contacting a patient to verify information with the system as taught by Kraft et al. and Liff et al. with the motivation of gathering accurate and reliable patient information thereby ensuring that the patient receives the correct prescription.

As per claim 25, Kraft et al. and Liff et al. teaches a medication dispensing system that storing information concerning a patient's medication requirements on the pharmacy system (14, Fig. 1) (see: Kraft et al.: column 4, lines 56-59). Kraft et al. further teaches a dispensing process where the nurse enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2), video display (26, Fig. 2) and printer (30, Fig. 2) all connected to the medication dispenser (see: Kraft et al.: column 4, lines 54-56). The information concerning the patient medication requirement is stored in the pharmacy system (14, Fig. 1) and when the medication package given to the patient include a label with information such as patient's name, room number, doctor's name and other data as required (see: Kraft et al.: column 4, lines 60 to column 5, lines 2).

Kraft et al. and Liff et al. fail to explicitly teach contacting the physician responsive to the failing of step (d).

The Examiner takes Official Notice that it is common in the medical field, for a patient or a physician to be contacted if the pharmacist in order to clarify any discrepancies or make any modification to the prescription does not verify prescription information. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of contacting a patient to verify information with the system as taught by Kraft et al. and Liff et al. with the motivation of gathering accurate and reliable patient information thereby ensuring that the patient receives the correct prescription.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

In related art (6,202,923) Boyer et al. discloses a method and an automated pharmacy system to alleviate the problem of printing labels for prescription.

In related art (6,351,688) Nichols et al. teaches an item dispensing system with a plurality of item dispensers at different locations.

In related art (5,404,384) Colburn et al. provides an inventory monitoring apparatus capable of real-time counting of objects from a location whose inventory is to be monitored.

In related art (5,805,456) Higham et al. teaches method and apparatus for providing access to items to be dispensed and for maintaining an inventory of the item.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (703) 605-4441. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

RWM
rwm
December 13, 2002

DINH X. NGUYEN
PRIMARY EXAMINER

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.